

## **REMARKS**

### **A. AMENDMENT TO THE CLAIMS**

Upon entry of this amendment claims 1 to 43 are pending in this Application. Claims 2, 5, 12, 13, and 14 have been amended. New claims 36 to 43 have been added. Support for amended claims 2 and 5, and new claim 36 is found, for example, in paragraphs [0048] and [0053] of the specification as filed. Support for the amended claims 12, 13, and 14, and new claims 37 to 43 is found, for example, in paragraphs [0040] to [0046] of the specification as filed.

### **B. SUMMARY OF TELEPHONE INTERVIEW WITH EXAMINER**

Applicant's attorney, Jacqueline M. Nicol, wishes to thank the Examiner for the telephone interview on Monday, January 29, 2007. During the interview Applicant requested clarification of the restriction requirement requiring election of species. The Examiner clarified that she required a species to be elected from both Group A and Group B.

### **C. RESTRICTION REQUIREMENT**

The Examiner maintains that the present application contains claims directed to the following patentably distinct species:

An electrochemical cell comprising a nonaqueous electrolyte comprising:

(A) one or more nonaqueous solvents:

- (1) acyclic ether (claim 12);
- (2) cyclic ether (claim 13 or specifically claim 22);
- (3) polyether (claim 14); or
- (4) a sulfone (claim 15); or
- (5) a dimethoxyethane and a dioxolane (claim 23)

and

(B) one or more N-O additives:

- (1) inorganic nitrates (claim 3) or (claim 7) or (claim 21) or (claim 28);
- (2) organic nitrates

- (3) inorganic nitrites (claim 4) or (claim 29); and
- (4) organic nitro compounds (claim 5).

The Applicant is required under 35 U.S.C. § 121 to elect, with or without traverse, a single disclosed species for prosecution on the merits.

**1. Election with Traverse**

In order to comply with the requirements of 37 C.F.R. § 1.142 and § 1.146, Applicant hereby provisionally elects with traverse: from Group (A) species (2), cyclic ether (claim 13 and 22, and new claims 38 and 40), and from Group (B) species (3), inorganic nitrites (claims 4 and 29).

The Examiner indicates that claims 1-2, 6, 8-11, 16-20, 24-27 and 30-35 are generic to all species. Applicant submits that new claims 37 and 39 are also generic. New claims 41 to 43 are believed by Applicant to be drawn to a new Group A species under the Examiner's classification.

Applicant respectfully submits the Examiner has not established a proper basis for requiring restriction of Applicant's claims under 35 U.S.C. § 121 and respectfully traverses the requirement for the reasons set forth below.

**2. Argument in Support of Restriction Requirement Traversal**

There are two criteria for a restriction requirement to be proper: (a) the inventions are either independent or distinct as claimed from each other; and (b) there is a serious burden on the Examiner if restriction is not required. MPEP § 803. The species for which restriction is required by the Examiner are members of Markush groups. When members of Markush groups are "sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all members of the Markush group in the claim on the merits, even though they may be directed to independent or distinct inventions." MPEP § 803.2, paragraph 2 (emphasis added). Applicant respectfully submits that each of the Markush groups for which election of a single species is required contains members sufficiently few in number that examination of the all the claims can be made without a serious burden on the Examiner. In such a case, the Examiner should not issue a restriction requirement. *Id.*

Further, the Examiner has not cited any art, facts or reasons why the search of the pending claims would be a serious burden as required by MPEP § 803 and § 808.02. Without such a showing the Examiner has not made a *prima facie* case for issuing a restriction requirement. In particular, the Examiner has not shown by appropriate explanation that the species in question are (1) separately classified, (2) where they are classified together, have a separate status in the art, or (3) require a different field of search. MPEP § 808.02. In fact, Applicant believes that the Examiner would find all relevant references in the same field of technology since the claimed invention is not a chemical compound, but is an electrochemical cell. The claims in the instant application are all directed to electric-current producing cells comprising a nonaqueous electrolyte that are classified in Class 429. Even the species of Group A are all non-aqueous electrolyte solvents for electrochemical cells and are thus all similarly classified, and Group B includes constituents of the electrolytes. Further in Applicant's U.S. Patent No. 7,019,494, in which similar claims were presented, restriction was not required. In summary, it is respectfully submitted that the Examiner has not established a *prima facie* case for restriction, but even if a *prima facie* case were established it would be rebutted by the evidence presented herein. It is thus believed that evaluation of all the pending claims would not provide an undue burden on the Examiner and would lead to more efficient prosecution. Applicant therefore respectfully requests that the restriction requirement be withdrawn.

### **CONCLUSION**

Applicant respectfully requests the Examiner to reconsider and withdraw the Restriction Requirement because there is no serious burden of examining all the claims in a single application on the merits, particularly since the invention as claimed is drawn to electrochemical cells in Class 429.

If the Restriction Requirement is made final, Applicant reserves the right to file one or more divisional applications of the non-elected species.

If there are any issues the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to **Deposit Account No. 19-3878**.

Respectfully submitted,

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Date

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